



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/492,844	01/27/2000	Joel Ronning	11684.05	1448

20322 7590 02/02/2004

SNELL & WILMER
ONE ARIZONA CENTER
400 EAST VAN BUREN
PHOENIX, AZ 850040001

EXAMINER

GARG, YOGESH C

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 02/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/492,844

Applicant(s)

RONNING ET AL.

AAL

Examiner

Yogesh C Garg

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 8, 9, 14-17, 19, 22, 23, 25, 30, 31, 36-39, 41 and 44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 8-9, 14-17, 19, 22-23, 25, 30-31, 36-39, 41, and 44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/13/2003 has been entered.

Response to Amendment

2. Amendment B, paper # 13, received on November 13, 2003 is acknowledged and entered. Claims 2, 4-7, 10-13, 18, 20-21, 24, 26-29, 32-35, 40, 42-43, 45-66 are cancelled. Claims 1, 3, 9, 14, 17, 19, 23, 25, 31, 36, 39, and 41 have been amended. Currently claims 1, 3, 8-9, 14-17, 19, 22-23, 25, 30-31, 36-39, 41, and 44 are pending for examination.

Response to Arguments

3. Applicant's arguments filed on November 13, 2003 concerning amended independent claims 1, 17, 23, and 39 have been fully considered but they are not

Art Unit: 3625

persuasive.

Regarding the applicant's arguments concerning claims 1 and 23 that the reference Downs does not teach determining if an order identifier is also active-corresponding order must not have been canceled before downloading the ordered file, and non-suppressed –order during a user's online –session (see amendment B, page 8), the examiner begs to differ for following reasons:

(a) The applicant has not disclosed in his arguments in amendment B support for the newly added the limitation, of “ determining if an order identifier is also active-corresponding order must not have been canceled before downloading the ordered file, and non-suppressed –order **during a user's online –session** “. The examiner also reviewed the disclosure and could not find the support. The applicant is requested to indicate support for this newly amended limitation in the disclosure.

(b) Downs discloses the limitation of “ determining if an order identifier is also active-corresponding order must not have been canceled before downloading the ordered file, and non-suppressed –order during a user's online –session (see at least FIG.6, col.24, lines 17-47, wherein Downs teaches that the Clearinghouse (s) 105 checks all transactions relating to sale before authorizing license and later checks if the user is permitted to use the authorized license and this corresponds to checking if the order is canceled before and after the order must not have been canceled after downloading the ordered file during a user's online session).

Regarding the applicant's arguments concerning claims 17 and 39 that the Official Notice reference does not teach automatically converting the identifier to a name

Art Unit: 3625

identifying a type of content of the file (see amendment B, page 9) the examiner does not agree as the Official Notice does teach the same because it is old and well-known, that when downloading/copying files from another source to the host computer the name of the file displayed automatically relates to the content and nature of the downloaded content, for example, if we copy an article for a school/college assignment from a web source it automatically displays a file name relating to the title/content of the article and only if we want to change it for storing in our computer then only it is changed.

In view of the above the rejection of independent claims 1, 17, 23, and 39 and their dependencies 3, 8, 9, 14, 15, 16, 19, 22, 25, 30, 31, 36, 37, 38, 41, and 44 is maintained.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3, 8-9, 14-16, 23, 25, 30-31, 36-38, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The independent claim(s) 1 and 23 contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession

Art Unit: 3625

of the claimed invention. The applicant has not disclosed in his arguments in amendment B support for the newly added the limitation, of " determining if an order identifier is also active-corresponding order must not have been canceled before downloading the ordered file, and non-suppressed –order **during a user's online – session** ". The examiner also reviewed the disclosure and could not find the support. The applicant is requested to indicate support for this newly amended limitation in the disclosure. Since claims 3, 8-9, 14-16, 25, 30-31, 36-38 are dependencies of claims 1 and 23 they will also inherit the same deficiency.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.1. Claims 1, 3, 8-9, 14-16, 23, 25, 30-31, and 36-38, are rejected under 35 U.S.C. 102(e) as being anticipated by Downs.

Regarding claims 1, 3, 8-9, 16, Downs teaches a method for secure downloading

Art Unit: 3625

of a file from a network comprising: receiving a selection of a file, receiving an order from a user, during an online session, for download of the selected file, the order including a file identifier related to the file and an order identifier related to the order, verifying the file identifier based upon particular information related to the file comprising one or more of the following: verifying a version identifier related to the file, a uniform resource locator for the file; or verifying the order identifier based upon particular information related to the order comprising a custom identifier associated with the user, verifying a transaction identifier associated with the order, and the particular information related to the order including: determining if the order identifier is valid for the order, meaning the order identifier exists for the order, determining if the order identifier is active, meaning the order was not canceled before the download of the file, and determining if the order identifier is non-suppressed, meaning the order was not canceled after the download of the file, during the online session, and selectively permitting the download of the file based upon a number of requested downloads based upon the verification of the file identifier, transaction identifier and the order identifier, receiving a selection of a uniform resource locator for the file and determining if the uniform resource locator is valid, active, non-suppressed or charged, also selectively downloading the file based upon a number of successful downloads of the file and upon a time parameter related to submission of the order, and denying the download based upon a customer identifier associated with the user (at least see, col.3, lines 40-55,*transferring the encrypted data....clearing house.....transferring the re-encrypted data.....to the user's system....*". col.7, lines 2-16, "*..licensing authorization and*

Art Unit: 3625

control....conditions of purchase and license, such as permitted number of copies, number of plays, and the time interval or term the license may be validenabling intermediate or End-User (s) to unlock content after verification of a successful completion of licensing transaction..”, col.8, lines 26-31, “..The architecture is open...Distribution of audio, programs, multimedia, video or other types of Content....”, col.10, lines 19-26, “... Once an Electronic Digital Content Store(s) 103 completes a valid request for Electronic Content 113 from an End-User(s).....The Electronic Digital Content Stores (s) also authorizes the download of the SC containing the Content 113 “, col.11, lines 30-54, “..The End-User Device(s) 109 can be any player device.....The End-User device (s) 109 manages the download and storage of SCs containing the Digital Content.....the use or running-on an End-User device(s) “, col.24, lines 17-47, “... Upon reception of the Order SC9s) 650 from the End-User Devices (09), the Clearinghouse (s) 105 verifies:2. that the order SC (s) 650 has not been altered.....Transaction Data 642 and Symmetric Key 623 are complete and authentic.....If the verifications are successful.....transfers the License SC (s) 660 to the End-User Device (s) 109....”, col.26,lines 24-58, “...When an End-User Devices (109 receives the Content.....Instead, the SC (s) includes an external URL.....to point to the Content 113.....Electronic Digital Content Store (s) 103 also.....extracting metadata information from them to build HTML pages.....present descriptions of Content 113 to End-User (s), usually so they can purchase the Content 113 “, col.27, lines 6-21, “..The End-User device (s) 109 receives the Transaction SC (s) 640 and validates the integrity of the Transaction SC (s) 640 and the included Offer SC (s)

Art Unit: 3625

641.....The Clearinghouse (s) 105 validates and processes Order SC (s) 650...access purchase Content 113", col.28, lines 30-50, "...Each record includesa URL that points to another SC (s) that includes the encrypted part...", col.29 line 18-col.30, line 62, "...[Content URL]....Content ID- A part that defines a unique ID assigned to a Content 113 item....SC Version-A version number assigned to the SC (s)...SC ID---", col.33, line 25-col.34, line 50, "...Transaction ID 535...End-User (s) ID---Verify the Digital Signature 643 of the SC (s).....Verify the integrity and authenticity of each Offer SC (s) 641 included in the Transaction SC (s) 640...", col.40, line 35-col.41, line 4, "...The ID property is a unique value ...T property specifies the type of the SC (s)...A property identifies the author or publisher....D property identifies the date...E property identifies the date, and optionally, the time that the SC (s) expires...CCURL value...CCURL property identifies the URL of the Clearinghouse (s) 105. The value should be the form of a valid external URL...", col.44, lines 5-42, "... Validation....The Clearinghouse(s) 105 begins the validation of Order SC 9s) 650 by verifying the digital signatures.....integrity of the Order SC (s) 650 parts...The process of verification of the Transaction and the Offer Sc (S)Then, the Storage Usage Conditions 519 of the Content 113...are validated by the Clearinghouse (s) 105.....", col.45, lines 15-28, "...In all the processing of the Order SC (s) 650 is successful...If the Clearinghouse (s) 105 is not able to successfully process the order SC (s) 650.....The HTML page indicates the reason that the Clearinghouse (s) 105 was unable to process the transaction ", col.46, lines 5-61, col.50, line 34-col.51, line 39, col.54, lines 55-64, col.59, line 7-col.60, line 13, col.72, lines 11-59, col.75, line 1-col.77, line 23, col.79, line 10-col.89, line 20.). Downs

Art Unit: 3625

further teaches determining if an order identifier is also active-corresponding order must not have been canceled before downloading the ordered file, and non-suppressed - order must not have been canceled after downloading the ordered file, (see Downs at least col.10, line 50-col.11, line 27, wherein Downs teaches that the Clearinghouse (s) 105 checks all transactions relating to sale before authorizing license and later checks if the user is permitted to use the authorized license and this corresponds to checking if the order is canceled before and after the order. Also see at least col.6, line 65-col.8, line 5, col.10, lines 19-48, col.81, line 10-col.82, line 22, col.85, lines 53-63.).

5.2. With regards to claims 14-15, the steps of requesting identification of a file name for storing the file, displaying a default identification as the file name for storing the file based upon an identification of the file and transmitting the generated file identifier for display to the user are inherent during the download.

5.3. With regards to apparatus claims 23, 25, 30-31, and 36-38, their limitations correspond to method claims 1, 3, 8-9, 14-16, and are, therefore, analyzed and rejected similarly.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3625

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6.1. Claims 17 and 39 are rejected under 35 U.S.C. 103(a) as being obvious over Edgar in view of Official Notice.

With regards to method claim 17, Downs teaches converting file identifiers for use in generating default storage file names for the corresponding files comprising: receiving an identifier related to a file, a request to download a file, receiving a uniform resource locator related to the file, automatically converting the identifier to a name related to content of the file (at least see, col.26, lines 36-46, "*.....End-User (s) efficiently download the containers.....the SC (s) includes an external URL.....*", col.27, lines 6-17, col.28, lines 32-37, col.29, lines 18-33, "*....[Content URL]....Content ID-A part that defines a unique ID assigned to a content 113 item...*", col.72, lines 35-59, "*...To handle the downloading of merchandize, the Electronic Digital Content Store (s) 103 is given a product ID....for each downloadable product that it acquires from the Content Promotions Web Site 156 for the Content Provider (s) 101.....These functions interact with the web server's commerce services to create and download to the End-User Device (s) 109 the files necessary.....*", and col.75, line 1-col.77, line 23). The steps of displaying a screen having a section displaying the name in a request for a file name and permitting the user to enter a file name for storing the file are inherent when copying and downloading files from a remote server to client's computer.

Art Unit: 3625

Downs further teaches the use of metadata to refer to the data of the contents of download and metadata is data about the content, such as, a song title for the downloaded song and this metadata, such as a song title is used to package the contents and also downloaded to the user (see col.9, lines 15-47). Downs also teaches that an end-user can use a tool to manage and customize his downloaded digital content library (see at least col.83, line 27-col.87, line 8) and thus he can name the downloaded content the way he likes it for his convenience.

Downs does not disclose automatically converting the identifier to a name related to the content of the downloaded content. However, it is old and well-known, that when downloading/ copying files from another source to the host computer the name of the file displayed automatically relates to the content and nature of the downloaded content, for example, if we copy an article for a school/college assignment from a web source it automatically displays a file name relating to the title/content of the article and only if we want to change it for storing in our computer then only it is changed. In view of the Official Notice, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Downs and incorporate the feature of the Official Notice, that is, to automatically convert the name/identifier of the downloaded file, while saving it, to a name which relates to the title/content of the downloaded matter because it will help the consumers to locate and retrieve the file later immediately without having to check a number of stored files.

Art Unit: 3625

6.2. With regards to apparatus claim 39 its limitations correspond to method claim 17 and is therefore, analyzed and rejected similarly.

7. Claims 19, 22, 41, 44, are rejected under 35 U.S.C. 103(a) as being unpatentable over Downs and further in view of Gross et al. (US Patent 6,263,353).

7.1. With regards to claims 19 and 22, Downs teaches a method for converting file identifiers for use in generating default storage file names for the corresponding files and receiving a uniform resource locator related to the file as disclosed in claim 18 and analyzed above. Downs does not disclose the steps of changing a format/network address of the uniform resource locator, associated with the file, to accommodate particular web browsers. However, Gross discloses changing a format/network address of the uniform resource locator, associated with the file, to accommodate particular web browsers (col.1, line 59-col.2, line 52, “*..As described above network addresses are recorded in differing formats.....In one aspect of the present invention, a method is provided for converting digital data representations...*”, Col.3, lines 1-2, “*..FIG.4a diagram illustrating a specific example of a network address conversion...*”, and col.3, line 32-col.4, line 4, “*.....As shown in FIG.2 the network monitor 110 includes a conversion module 210 that converts the particular network address format.....to another address format.....*”). In view of Gross, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Downs to incorporate the feature of changing a format/network address of the uniform resource locator to

Art Unit: 3625

accommodate particular web browsers. Doing so would help to the correct decoding of the whole network address, represented in different ways, at the receiving end of an address received from another computer, as suggested by Gross (at least see, col.1, lines 13-31).


7.2. With regards to apparatus claim 41, and 44, their limitations correspond to method claims 19 and 22 and are, therefore, analyzed and rejected similarly.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.


YCG
Jan 23, 2004.

Yogesh C Garg
Examiner
Art Unit 3625


Jeffrey A. Smith
Primary Examiner